

REMARKS

Accordingly, claims 1-30 remain pending in the application. No new matter has been added by the amendment. Entry of the foregoing amendment is requested.

The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Further, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references. No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Moreover, the amendment or cancellation of claims herein is without prejudice to pursuing claims of different scope by way of continuing Application.

Claim Rejections under 35 U.S.C. § 103

Claims 1-30 were rejected under 35.U.S.C. § 103(a) as being unpatentable over Kostreski et al. (U.S. Patent No. 5,729,549, hereinafter Kostreski et al.) in view of Rostoker et a. (U.S. Patent No. 5,784,572, hereinafter Rostoker et al.). Applicants' respectfully traverse the rejection and request reconsideration.

It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2142). To establish a *prima facie* case three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.

TRAVERSE (i): There is no motivation or suggestion contained in the cited art to combine the teachings of the references.

Before obviousness may be established, the Office Action must show that there is either a suggestion in the art (Kostreski et al.; Rostoker et al.) to produce the claimed invention or a compelling motivation based on sound scientific principles. Ex Parte Kranz, 19

USPQ2d, pp. 1216 through 1219; decided June 28, 1990, BPAI. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572 at 1577. The critical inquiry is whether there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. Fromson v. Advance Offset Plate, 755 F.2d 1549 at 1556. The Office Action fails to show either a suggestion in the art or a compelling motivation based on sound scientific principles to combine the references and therefore the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

TRAVERSE (ii): The combination does not provide applicants' claimed invention.

The cited prior art does not teach or suggest decoding audio or video data that is based on a plurality of encoding methods. Kostreski et al. teaches a single, specific encoding method (MPEG). By contrast, the claimed invention teaches the use of multiple encoding methods in operation. Kostreski et al. teaches a broadband network providing substantially concurrent distribution of multiple RF channels from separately located transmitters (column 1, lines 16-20). Kostreski et al. goes on to teach that a digital audio/video processor (125) transmits and processes MPEG encoded signals (column 21, lines 8-30). Kostreski et al. further teaches that MPEG audio and video decoders (129 and 131) processes MPEG encoded signals (column 21, lines 32-43). Kostreski et al. does not teach or suggest other encoding methods besides MPEG, nor does the apparatus and method taught by Kostreski et al. disclose or teach encoding and decoding of multiple encoding formats.

Contrary to assertions by Examiner, Kostreski et al. at column 12, lines 13-17 does not teach audio and video data based on a plurality of encoding methods. Kostreski et al. teaches encoding using "a" standardized digitization and compression technique, such as MPEG "or" DIGICIPHER, with the preferred embodiment being MPEG II. Clearly, Kostreski et al. teaches the use of only one encoding method and not a plurality of encoding methods. Throughout the patent application, Kostreski et al. teaches the use of the MPEG encoding method only, which is illustrated in FIG. 8 where MPEG audio and video decoders (129 and 131) are used. Kostreski et al. does not teach or suggest the use of audio and video

data based on a plurality of encoding methods as claimed in applicant's independent claims 1, 9, 16, 21, 25 and 29.

Rostoker et al. teaches an apparatus for compressing and decompressing digital video and audio signals. Although Rostoker teaches that different compression algorithms can be used to perform the compression function, Rostoker does not teach or suggest the use of multiple encoding methods, which as defined in the present claimed invention, are not mere compression algorithms. Rostoker contemplates only a single encoding method, referring in column 2, line 37 to the use of "a standard such as the MPEG standard", and teaches plurality only of the compression function.

Applicant's claimed invention decodes audio and video signals based on a plurality of encoding methods. This plurality of encoding methods is not merely a plurality of compression algorithms applicable to a single standard. An encoding method as defined in Applicant's specification necessarily performs encoding function(s) other than compression: "Depending on the encoding method, data compression may **also** be included" (page 11, lines 3-7, emphasis added). Thus, it is implicit that an encoding method is not limited to the compression function. Examples of such encoding methods include ADPCM, CD-DA, Real Audio, WAV, ClearVideo, Sony DV, etc., as well as the MPEG standard. (See page 10, line 30 – page 11, line 7, and page 13, lines 16 – 25.

The apparatus taught by Rostroker et al. focuses exclusively on the MPEG family of standards and does not teach the use of other formats. This is illustrated by the fact that the apparatus taught by Rostroker et al. uses discrete cosine transforms in its compression and decompression method (column 2, lines 40-43), which are MPEG specific and not applicable to video standards outside of the MPEG family of standards. As pointed out by the Examiner, Rostroker et al. discloses alternate standards in the "Background" section, but merely discusses the individual use of such standards in contrast with the individual use of the MPEG standard. Rostroker et al. does not teach the use of these other standards in plurality. Rostroker et al. does not teach or suggest the use of audio and video data based on a plurality of encoding methods as claimed in applicant's independent claims 1, 9, 16, 21, 25 and 29.

Applicants' respectfully submit that independent claims 1, 9, 16, 21, 25 and 29 as drafted clearly distinguish over the cited art. In particular, neither Kostreski et al. nor

Rostroker et al. disclose or teach the use of audio and video data based on a plurality of encoding methods. Kostreski et al. and Rostroker et al., individually or in combination, do not contain at least these features of the applicants' claims 1, 9, 16, 21, 25 and 29, they do not include all of the elements of applicants' independent claims 1, 9, 16, 21, 25 and 29, and therefore cannot anticipate applicants' independent claims. Applicants respectfully submit that there is no suggestion to combine the references, and if they could be properly combined, do not lead to the Applicants' invention, and that any valid combination is merely hindsight reconstruction of Applicants' invention.

Claims 2 and 4-5 depend either directly or indirectly from claim 1 and are believed to be allowable over the relied on references for at least the same reasons as claim 1.

Claims 10 and 12-13 depend either directly or indirectly from claim 9 and are believed to be allowable over the relied on references for at least the same reasons as claim 9.

Claims 17-18 depend either directly or indirectly from claim 16 and are believed to be allowable over the relied on references for at least the same reasons as claim 16.

Claims 22-24 depend either directly or indirectly from claim 21 and are believed to be allowable over the relied on references for at least the same reasons as claim 21.

Claims 26-28 depend either directly or indirectly from claim 25 and are believed to be allowable over the relied on references for at least the same reasons as claim 25.

Claim 30 depends directly from claim 29 and is believed to be allowable over the relied on references for at least the same reasons as claim 29.

Fees/Extension of Time

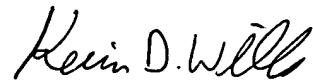
It is respectfully pointed out that a three month extension of time under 37 C.F.R. § 136(a) has been requested. The Commissioner is hereby authorized to charge \$920.00 to Deposit Account No. 13-4771 for the three month extension of time.

Summary

Reconsideration is respectfully requested. In view of the foregoing remarks, it is believed that the application is in condition for allowance. Notice to that effect is respectfully requested.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 13-4771.

Respectfully submitted,
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